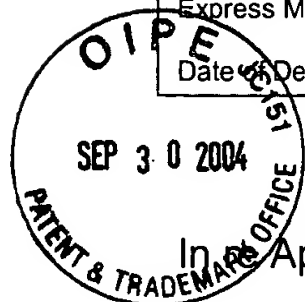


U.S.P.S. EXPRESS MAIL "POST OFFICE TO ADDRESSEE" SERVICE
DEPOSIT INFORMATION

Express Mail Label No.: EV 330129327 US

Date of Deposit: September 30, 2004

BRINKS
HOFER
GILSON
& LIONE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln of: Erwin Spanner

U.S. Patent Application Serial
No.: 09/661,663

Art Unit: 2863

U.S. Filing Date: September 14, 2000

Confirmation No: 9189

RCE Filing Date: December 10, 2003

For: DEVICE FOR POSITION INDICATION AND
DETECTION OF GUIDANCE ERRORS

Examiner: Shah, Kamini S.

Attorney Docket No: 56/344

Mail Stop Patent Ext.
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Request For Reconsideration Of Patent Term Adjustment Pursuant To 37 C.F.R. § 1.705(b) with Exhibits A-E attached
- ☒ Return Receipt Postcard

Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☒ A petition or processing fee in an amount of \$200.00 under 37 C.F.R. § 1.18(e)
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$9=			x \$18=	
Indep.		Minus			x \$43=			x \$86=	
First Presentation of Multiple Dep. Claim					+\$145=			+\$290=	
					Total	\$		Total	\$

Fee payment:

- ☒ A check in the amount of \$200.00 to cover the patent term extension is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

September 30, 2004
September 30, 2004

Respectfully submitted,

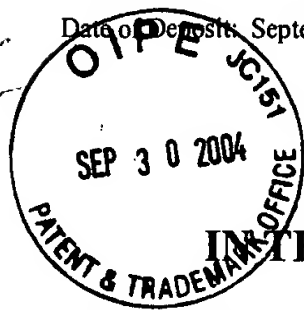
John C. Freeman
John C. Freeman (Reg. No. 34,483)

01/01/04

DAC/EFW

"Express Mail" mailing label number EV 330129327 US

Date of Deposit: September 30, 2004



Our Case No. 56/344

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Erwin Spanner

Serial No. 09/661,663

Filing Date: **September 14, 2000**

RCE Filing Date: **December 10, 2003**

Title: **DEVICE FOR POSITION INDICATION
AND DETECTION OF GUIDANCE
ERRORS**

)
)
)
) Examiner: **Shah, Kamini S.**
)
) Group Art Unit No. **2863**
)
) Confirmation No. **9189**
)
)
)
)

**REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705(b)**

Mail Stop Patent Ext
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A Notice of Allowance was issued for the present application on **June 30, 2004** indicating that the issue fee is due on **September 30, 2004**. The issue fee is being submitted for the present application in conjunction with this request for reconsideration of the patent term adjustment. The Patent Application Information Retrieval (PAIR) system and the notice of allowance both indicate a patent term adjustment that was calculated by the U.S. Patent office pursuant to 37 C.F.R. 1.701 of **fifty seven (57)** days. A copy of Notice of Allowance for the present application is included herewith as Exhibit A.

10/05/2004 WABDEL3 00000006 09661663 200.00 DP
01 FC:1455

Applicant's Attorney believes that the patent term adjustment should be **three hundred thirty (330)** days. For the reasons stated herein, reconsideration of the patent term adjustment is respectfully requested pursuant to 37 C.F.R. 1.705(b). A check in the amount of \$200.00 is attached so as to cover the petition fee pursuant to 37 C.F.R. § 1.18(e). Please charge any additional fee required or credit for any excess fee paid to Deposit Account No. 23-1925. A duplicate copy of this Petition is attached.

The patent term adjustment for the present application was calculated by the U.S. Patent and Trademark Office based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system Patent Term Adjustment History, attached as Exhibit B. Applicant's Attorney believe that errors and/or omissions in the calculation and/or the PAIR system Patent Term Adjustment History may have resulted in an incorrect patent term adjustment for the present application as described in detail below. The present application is not subject to a terminal disclaimer.

Period of adjustment pursuant to 37 C.F.R. § 1.703(a)(1)

The period of adjustment pursuant to 37 C.F.R. § 1.703(a)(1) is the number of days in the period beginning on the day ("the 14 month date") after that date that is fourteen months after the date on which the application was filed pursuant to 35 U.S.C. § 111(a), or fulfilled the requirements pursuant to 35 U.S.C. § 371, and ending on the date of mailing or either an action pursuant to 35 U.S.C. § 132 or a notice of allowance pursuant to 35 U.S.C. § 151, whichever comes first. Applicants agree with the calculated delay of one hundred twenty five (125) days as reflected in the PAIR system Patent Term Adjustment History, attached as Exhibit B.

Period of adjustment pursuant to 37 C.F.R. § 1.703(a)(6)

The period of adjustment pursuant to 37 C.F.R. § 1.703(a)(6) is the number of days in the period beginning on the day (“the 4 month date”) after that date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued.

In the present application, the issue fee was filed on **December 23, 2002** as evidenced by a copy of the Patent Term Adjustment History, attached as Exhibit B. The 4 month date is therefore **April 23, 2003**. On December 11, 2003, Applicant’s filed a Petition requesting that the application be withdrawn from issuance so that a Request for Consideration could be concurrently filed and a Supplemental Information Disclosure Statement be considered and made of record. The Petition was granted on December 19, 2003 (Exhibit C attached). Since no patent was granted from April 23, 2003 to December 19, 2003, Applicant’s Attorney believes that the difference between the 4 month date and the date of mailing of the Petition is **two hundred forty (240)** days. However, the PAIR system Patent Term Adjustment History, attached as Exhibit B, does not indicate any “4 month” delay is warranted. Applicant’s Attorney therefore believes that the lack of any “4 month” delay indicated in the PAIR system Patent Term Adjustment History, attached as Exhibit B is incorrect. Applicant’s Attorney respectfully requests correction of the “4 month” delay so as to reflect the delay from Applicant’s filing of the issue fee on December 23, 2002 to December 19, 2003, wherein a patent had still not been issued.

Reduction in Period of Adjustment pursuant to 37 C.F.R. § 1.704

Period of adjustment pursuant to 37 C.F.R. § 1.704(b)

Pursuant to 37 C.F.R. § 1.704(b), the period of adjustment shall be reduced by the number of days, if any, beginning on the day after the date (the 3 month date) that is three months after the date of mailing or transmission of an Office communication notifying the applicant of a rejection, objection, etc., and ending on the date a corresponding reply was filed.

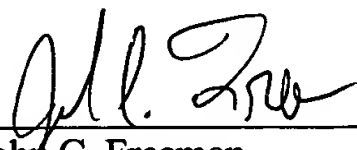
In the present application, an Office Action was mailed on March 19, 2002 (attached as Exhibit D). Subsequently, a Supplemental Office Action was mailed on **April 22, 2002** (attached as Exhibit E). Since the Supplemental Office Action replaced the Office Action mailed on March 19th (see PAIR entries dated April 19 and 22, 2002 (Exhibit B) indicating that period of response restarted), the 3 month date was therefore **July 22, 2002**. A response by the Applicant's Attorney to the Office Action was filed with the U.S. Patent and Trademark Office on **August 26, 2002** as evidenced by the Patent Term Adjustment History, attached as Exhibit B. Accordingly, a delay of thirty five (35) days occurred. However, PAIR calculated the delay of sixty eight (68) days based on the date of mailing of the initial March 19, 2002 Office Action. As indicated above, the mailing of the April 22, 2002 Office Action reset the response period, and so the delay should have been calculated from April 22, 2002 and not March 19, 2002. Accordingly, Applicant's Attorney respectfully requests correction of the date of mailing of the Office Action that initiated the three month response time limit and re-calculation of the patent term adjustment taking the corrected date of mailing into account.

Total patent term adjustment

For the present application, the total patent term adjustment pursuant to 37 C.F.R. § 1.703(f) is the period of adjustment pursuant to 37 C.F.R. § 1.703 reduced by any delays pursuant to 37 C.F.R. § 1.704. Thus, according to our calculations, we believe that the patent term adjustment should be $(125+240)$ days - (35) days = 330 days, instead of 57 days indicated on the Notice of Allowance attached as Exhibit A.

It is respectfully asserted that the patent term adjustment determined by the U.S. Patent and Trademark Office for the present application may not be correct. Accordingly, Applicant's Attorney respectfully requests the U.S. Patent and Trademark office to reconsider, and make revisions to the PAIR system Patent Term Adjustment History in view of the previous remarks. In addition, it is respectfully requested that the patent term adjustment be re-calculated by the U.S. Patent and Trademark Office in view of the above remarks. Office personnel are invited to contact the undersigned attorney for the Applicant's Attorney via telephone if such communication would be beneficial in fulfilling this request.

Respectfully submitted,

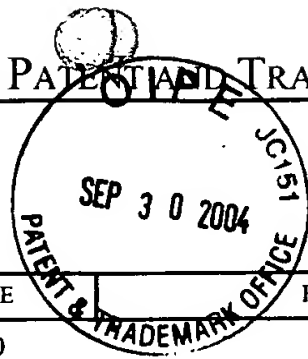


John C. Freeman
Registration No. 34,483
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200



UNITED STATES PATENT AND TRADEMARK OFFICE



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,663	09/14/2000	Erwin Spanner	56/344	9189
757	7590	06/30/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			SHAH, KAMINI S	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 06/30/2004

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 57 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 57 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



UNITED STATES PATENT AND TRADEMARK OFFICE

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NOTICE OF ALLOWANCE AND FEE(S) DUE

757

7590

06/30/2004

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

SHAH, KAMINI S

ART UNIT

PAPER NUMBER

2863

DATE MAILED: 06/30/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,663	09/14/2000	Erwin Spanner	56/344	9189

TITLE OF INVENTION: DEVICE FOR POSITION INDICATION AND DETECTION OF GUIDANCE ERRORS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$50	\$0	\$50	09/30/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHT. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THE STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issued on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is the patentee's responsibility to ensure timely payment of maintenance fees when due.



United States Patent and Trademark Office

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PATENT APPLICATION INFORMATION RETRIEVAL



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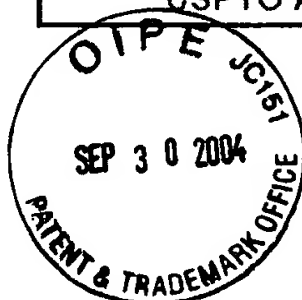
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Contacts

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Patent Term Adjustment (PTA) for publication number: 09/661,663

			Days
Filing or 371(c) Date:	09-14-2000	USPTO Delay (PTO):	125
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	68
Post-Issue Petitions (days):	+0	Total PTA:	57
USPTO Adjustment (days):	+0	Explanation of Calculations	



Select Search Option

Assignments

Search

Display References

Image File Wrapper

File History

Publication Review

Patent Term Adjustment History

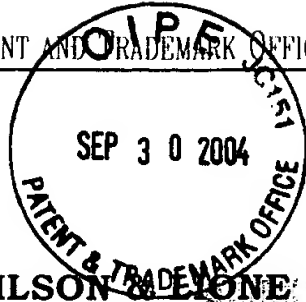
Date	Contents Description	PTO (days)	APPL (days)
06-30-2004	Mail Notice of Allowance		
06-29-2004	Issue Revision Completed		
12-11-2003	Reference capture on IDS		
06-25-2004	Notice of Allowance Data Verification Completed		
06-25-2004	Notice of Allowability		
06-24-2004	IFW TSS Processing by Tech Center Complete		
05-18-2004	Miscellaneous Incoming Letter		
06-24-2004	Date Forwarded to Examiner		
05-18-2004	Response after Non-Final Action		
05-18-2004	Workflow incoming amendment IFW		
04-29-2004	Mail Examiner Interview Summary (PTOL - 413)		
04-12-2004	Examiner Interview Summary Record (PTOL - 413)		
03-23-2004	Mail Non-Final Rejection		
03-22-2004	Non-Final Rejection		
03-17-2004	Date Forwarded to Examiner		
12-15-2003	Request for Continued Examination (RCE)		
03-17-2004	Express Abandonment (for Entry of CPA / RCE / Rule129)		
12-15-2003	Information Disclosure Statement (IDS) Filed		
02-18-2004	Receipt into Pubs		
02-17-2004	Dispatch to Publications		
02-17-2004	Issue Revision Completed		
02-09-2004	Mail Notice of Allowance		
02-05-2004	Notice of Allowance Data Verification Completed		
02-05-2004	Notice of Allowability		
12-11-2003	Information Disclosure Statement (IDS) Filed		



01-22-2004	Date Forwarded to Examiner		
12-11-2003	Request for Continued Examination (RCE)		
01-22-2004	Express Abandonment (for Entry of CPA / RCE / Rule129)		
12-19-2003	Record Petition Decision of Granted to Withdraw from Issue		
12-18-2003	Workflow - Query Request - Finish		
12-18-2003	Receipt into Pubs		
12-11-2003	Petition Entered		
12-15-2003	Workflow - Request for RCE - Begin		
12-23-2002	Mailroom Date of Issue Fee Payment		
09-14-2000	Workflow - Drawings Finished		
09-14-2000	Workflow - Drawings Matched with File at Contractor		
12-23-2002	Issue Fee Payment Recorded		
12-03-2002	Receipt into Pubs		
12-20-2002	Workflow - Customer Service Request - Finish		
11-20-2002	Workflow - Customer Service Request - Begin		
01-06-2003	Application Is Considered Ready for Issue		
10-29-2002	Receipt into Pubs		
10-03-2002	Workflow - File Sent to Contractor		
10-03-2002	Receipt into Pubs		
10-02-2002	Dispatch to Publications		
09-27-2002	Mail Notice of Allowance		
09-27-2002	Notice of Allowance Data Verification Completed		
09-27-2002	Notice of Allowability		
09-13-2002	Date Forwarded to Examiner		
08-26-2002	Response after Non-Final Action		68
08-26-2002	Request for Extension of Time - Granted		<input type="checkbox"/>
04-22-2002	Mail Examiner Interview Summary (PTOL - 413)		<input type="checkbox"/>
04-22-2002	Mail Notice of Restarted Response Period		<input type="checkbox"/>
04-19-2002	Letter Restarting Period for Response (i.e. Letter re: References)		<input type="checkbox"/>
04-16-2002	Examiner Interview Summary Record (PTOL - 413)		<input type="checkbox"/>
03-19-2002	Mail Non-Final Rejection	125	<input type="checkbox"/>
03-19-2002	Non-Final Rejection	<input type="checkbox"/>	
02-22-2002	Case Docketed to Examiner in GAU	<input type="checkbox"/>	
02-22-2002	Case Docketed to Examiner in GAU	<input type="checkbox"/>	
04-30-2001	Information Disclosure Statement (IDS) Filed	<input type="checkbox"/>	
03-31-2001	Case Docketed to Examiner in GAU	<input type="checkbox"/>	
09-14-2000	Request for Foreign Priority (Priority Papers May Be Included)	<input type="checkbox"/>	
02-06-2001	Application Dispatched from OIPE	<input type="checkbox"/>	
02-02-2001	Application Is Now Complete	<input type="checkbox"/>	
11-14-2000	Notice Mailed--Application Incomplete--Filing Date Assigned	<input type="checkbox"/>	
11-13-2000	Correspondence Address Change	<input type="checkbox"/>	
10-11-2000	IFW Scan & PACR Auto Security Review	<input type="checkbox"/>	
09-14-2000	Initial Exam Team nn	<input type="checkbox"/>	



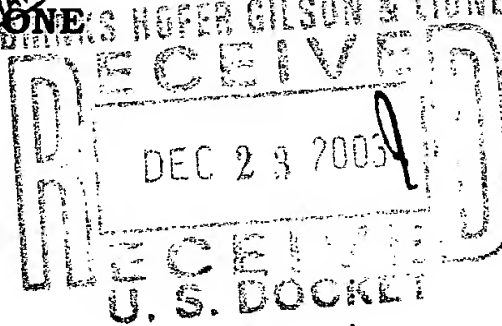
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Paper No. _____

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CHICAGO, IL 60611



COPY MAILED

DEC 19 2003

OFFICE OF PETITIONS

In re Application of
Erwin Spanner
Application No. 09/661,663
Filed: September 14, 2000
Attorney Docket No. 56/344

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)
:

This is a decision on the petition, filed December 11, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 23, 2002 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.¹

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2863 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.



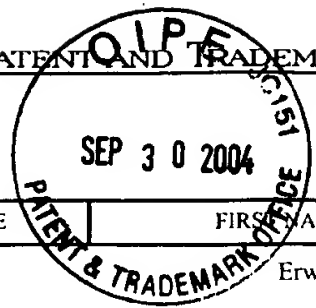
Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



UNITED STATES PATENT AND TRADEMARK OFFICE

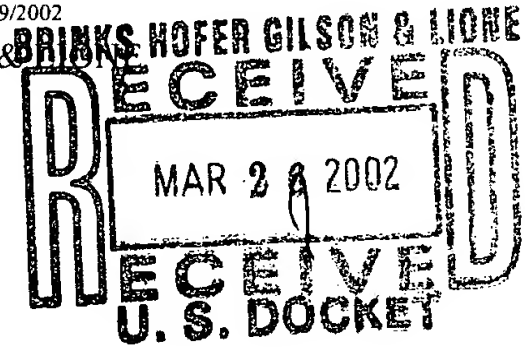
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov



APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,663	09/14/2000	Erwin Spanner	56/344	9189

757 7590 03/19/2002

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610



EXAMINER

SHAH, KAMINI S

ART UNIT	PAPER NUMBER
----------	--------------

2863

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary



Application No.

09/661,663

Applicant(s)

SPANNER, ERWIN

Examiner

Kamini S Shah

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.



DETAILED ACTION

Specification

1. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).
2. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: pages 3 and 4 of specification refers back to EP 0 387 520 for various features. It is not understood how the preset invention is different than conventional measuring device. Further more page 7 refers to EP 0 082 441, which is not understood where the art is incorporated by reference or not. Pages 9, 11, 12, and 13, of specification refers to EP 0 387 520 for two scanning units and signal generation, however it is not understood where the art is incorporated by reference or not. Additionally, pages 14 and 15 refers to EP 0 082 441, it is not understood.

Applicant is required to submit an amendment, which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

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Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernst (4,951,399).

7. Regarding to claimed invention, Ernst teaches a measuring device for measuring position indication and the detection of guidance errors comprising a graduation (Ta) in a graduation plane (TFa) of the graduation carrier (TTa) which is connected to one of the objects as to claimed position measuring graduation arranged in a position measurement direction; the claimed first and second guidance error measuring graduation arranged perpendicularly with respect to position measurement graduation,

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Ernst teaches guide surface perpendicular to the graduation surface of the graduation carrier, and comprising a guide coupling perpendicular to the direction of measurement to connect the guide elements. Ernst further discloses position indication scanning unit movable with respect to the scale such as scanning unit (A), see at least abstract and col. 2, lines 36-63. With regard to claimed elements such as scanning unit comprises light source that emits beams of light, a retro-reflection component and a detector element, Ernst discloses that in order to scan the graduation TTa, the scanning unit comprises arrangement that is known to those skilled in the art, a scanning plate AP with a scanning graduation, a lighting unit and at least one photoelement, see col. 3, lines 29-33.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamini S Shah whose telephone number is 703-305-9590. The examiner can normally be reached on IFP.

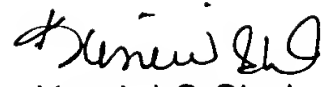
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John H Hilten can be reached on 703-308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Application/Control Number: 09/661,663

Page 5

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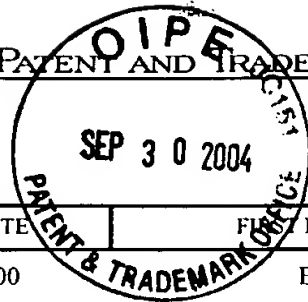
Kamini S Shah
Primary Examiner
Art Unit 2863

kss

March 16, 2002



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FILED NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,663	09/14/2000	Erwin Spanner	56/344	9189

757 7590 04/22/2002

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

SHAH, KAMINI S

ART UNIT PAPER NUMBER

2863

DATE MAILED: 04/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

BRINKS HOFER GILSON & LIONE
RECEIVED
APR 25 2002
RECEIVED
U. S. DOCKET

Office Action Summary



Application No. 09/661,663		Applicant(s) SPANNER, ERWIN	
Examiner Kamini S Shah		Art Unit 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
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- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernst (4,951,399).

3. Regarding to claimed invention, Ernst teaches a measuring device for measuring position indication and the detection of guidance errors comprising a graduation (Ta) in a graduation plane (TFa) of the graduation carrier (TTa) which is connected to one of the objects as to claimed position measuring graduation arranged in a position measurement direction; the claimed first and second guidance error measuring graduation arranged perpendicularly with respect to position measurement graduation, Ernst teaches guide surface perpendicular to the graduation surface of the graduation carrier, and comprising a guide coupling perpendicular to the direction of measurement to connect the guide elements. Ernst further discloses position indication scanning unit movable with respect to the scale such as scanning unit (A), see at least abstract and col. 2, lines 36-63. With regard to claimed elements such as scanning unit comprises light source that emits beams of light, a retro-reflection component and a detector element, Ernst discloses that in order to scan the graduation TTa, the scanning unit comprises arrangement that is known to those skilled in the art, a scanning plate AP

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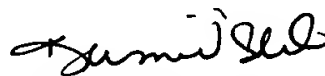
with a scanning graduation, a lighting unit and at least one photoelement, see col. 3, lines 29-33.

4. Claims 10-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamini S Shah whose telephone number is 703-305-9590. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John H Hilten can be reached on 703-308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Kamini S Shah
Primary Examiner
Art Unit 2863

kss
April 16, 2002

fax

Interview Summary	Application No.		Applicant(s)	
	09/661,663		SPANNER, ERWIN	
	Examiner		Art Unit	
	Kamini S Shah		2863	

All participants (applicant, applicant's representative, PTO personnel):

(1) Kamini S Shah. (3) _____

(2) John C. Freeman. (4) _____

Date of Interview: 16 April 2002 .

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____ .

Claim(s) discussed: _____ .

Identification of prior art discussed: _____ .

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

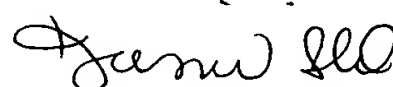
Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The last Office Action mailed on 3/19/02 had given a One month of statutory period to response because of the objection to the specification under 37 CFR 1.71, as being incomprehensible. However, examiner acknowledge the cited four foreign patents were incorporated by reference and were cited on IDS filed 4/30/01. In the attached Office action Examiner have wave the objection and restarts the statutory period .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.